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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/807,675

07/09/2001

Nicholas Paul Elliott

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04/20/2006

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EXAMINER

KLIMACH, PAULA W

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/807,675

Applicant(s)

ELLIOTT ET AL.

Examiner

Paula W. Klimach

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on 12/07/05. The amendment filed on 12/07/05 have been entered and made of record. Therefore, presently pending claims are 1-17.

### ***Response to Arguments***

Applicant's arguments filed 12/07/05 have been fully considered but they are not persuasive because of following reasons.

Applicant requested that the next PTO Action acknowledge the information disclosure statement filed on July 27, 2001. This is not found persuasive. The record does not contain a document filed on July 27, 2001. The examiner advises the applicant to confirm the date and the record.

Applicant argued that 11-14 have been amended to require the goods to have public data and a security code applied thereto. This does not overcome the non-statutory rejection. The claims are still broad enough that to encompass printed material with printed public data thereon with a security code, for example a barcode, printed thereon. Further the applicant argued that the rejection does not provide an explanation as to why printed matter with a verification mark, such as a digital signature is non-statutory matter. Printed matter is an example of an abstract idea, which merely manipulates an abstract idea without producing a useful, concrete, and tangible result.

In reference to applicant's further arguments, the additional reference of Shefi has been introduced.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 11-14** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite “Goods marked for verification...” the claims are broad enough to read on printed matter with a verification mark (such as digital signature).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith et al (6,069,955) in view of Shefi (6,266,413 B1)

*In reference to claims 7, 11, and 15-16* Coppersmith discloses a system for protection of goods against counterfeiting (title), characterized in that the label contains a security code (security code; serial number), product name, and the manufacturing information is applied to the goods (column 4 lines 8-10) therefore public data is made available on the product itself on

the label; therefore applied to the goods (column 2 lines 65-67) for use in a subsequent verification process (column 4 lines 38-40).

Coppersmith discloses a system for checking authenticity, which should enable the easy identification of counterfeit product labeling (column 4 lines 38-40) wherein a verifier holds the private data sets. However Coppersmith does not disclose encryption algorithm by encrypting public data applied to the goods and one of a plurality of private data sets.

Shefi discloses a system wherein encryption algorithm by encrypting public data applied to the goods and one of a plurality of private data sets (column 17 line 20 to column 18 line 10). In the reference of Shefi the one-time-pad corresponds to the private data that is distributed only to those that are to decrypt the message (STEP TWO Fig. 2D). The message that is to be encrypted (STEP THREE FIG. 2D) corresponds to the public data. The predetermined encryption algorithm is the algorithm that is used to encrypt the message (column 17 lines 60-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the one time pad of Shefi to encrypt the public information that is provided by Coppersmith in order for that system of authenticate the goods. One of ordinary skill in the art would have been motivated to do this because the use of the one-time pad forms a theoretically unbreakable, by brute force, encryption system (column 3 lines 19-38).

*In reference to claims 1 and 17*, Coppersmith discloses a system for protection of goods against counterfeiting (title), and therefore a system for verifying the authenticity of goods. Coppersmith discloses a system and method that comprises a security code is applied to the goods (column 4 lines 8-10), said security code having been derived by means of a

predetermined encryption algorithm from said public data applied to the goods and a plurality of private data sets held by a verifier (column 2 lines 42-67); and, upon receiving a request for verification, each private data set is entered into said predetermined encryption algorithm together with the public data applied to the goods, the verification codes is compared with the security code applied to the goods to assess the authenticity of goods (column 2 lines 57-67 and column 3 lines 31-58).

Coppersmith discloses a system for checking authenticity, which should enable the easy identification of counterfeit product labeling (column 4 lines 38-40) wherein a verifier holds the private data sets. However Coppersmith does not disclose encryption algorithm by encrypting public data applied to the goods and one of a plurality of private data sets.

Shefi discloses a system wherein encryption algorithm by encrypting public data applied to the goods and one of a plurality of private data sets (column 17 line 20 to column 18 line 10). In the reference of Shefi the one-time-pad corresponds to the private data that is distributed only to those that are to decrypt the message (STEP TWO Fig. 2D). The message that is to be encrypted (STEP THREE FIG. 2D) corresponds to the public data. The predetermined encryption algorithm is the algorithm that is used to encrypt the message (column 17 lines 60 to column 18 line 10). The result is generating a cipher text (list of verification codes each of said verification codes) being generated by predetermined encryption algorithm (column 18 lines 1-10). The system creates the cipher text by encrypting the message (public data) and one of said plurality of private data sets (one-time pads).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the one time pad of Shefi to encrypt the public information that is provided

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by Coppersmith in order for that system of authenticate the goods. One of ordinary skill in the art would have been motivated to do this because the use of the one-time pad forms a theoretically unbreakable, by brute force, encryption system (column 3 lines 19-38).

*In reference to claims 3, 8 and 12*, wherein the public plain text includes a batch number. Coppersmith indicates that the product could be a container of items, and therefore a batch (column 2 lines 44-45).

*In reference to claims 4, 9, and 13*, wherein the public plain text includes date information (column 4 lines 26-27).

*In reference to claim 5*, wherein the private plain text includes an item number (column 4 lines 26-27).

*In reference to claims 6, 10, and 14*, wherein said public plain text and said security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (column 4 lines 19-22 and lines 58-59).

**Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith and Shefi as applied to claim 1 above, and further in view of Tran (5,864,665).

Coppersmith does not disclose a system wherein the verifier maintains a log of requests for verification and, upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

Tran discloses a method of auditing login activity (abstract), where login activity is used to verify that users are who they say they are, by maintaining a record of valid login (column 7 lines 54-60 and column 8 lines 44-47). This information may generally used for verification

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upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to maintain a log of verification requests as in Tran in the system of Coppersmith. One of ordinary skill in the art would have been motivated to do this because the log would provide a record of the goods needing verification.

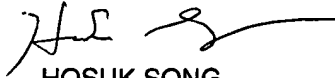
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK  
Friday, April 14, 2006

  
HOSUK SONG  
PRIMARY EXAMINER